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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,901	11/29/2001	Richard D. Ellis	120073.424	4144

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,901

Applicant(s)

ELLIS ET AL.

Examiner

Michael Bekerman

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/28/2002</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 4 - 440. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The abstract of the disclosure is objected to because it is longer than the required 150 word limit. Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claim 21 is objected to because of the following informalities: This claim fails to further limit the method of the parent claim. The purpose of the communication packet does not limit the step of forwarding. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 5, 12, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 5, the term "imperceptibly impacts" is a relative term which renders the claim indefinite. The term "imperceptibly impacts" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Different people may view performance differently, so while one person may notice the game slow down, another may not. Further, different computers may have more memory, so the step of receiving may perform differently for one computer as opposed to another.

Regarding claim 12, the term "minimizes performance degradation" is a relative term which renders the claim indefinite. The term "minimizes performance degradation"

is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Different people may view performance differently, so while one person may notice the game slow down, another may not. Further, different computers may have more memory, so the step of receiving may perform differently for one computer as opposed to another.

Regarding claim 19, this claim recites the limitation "view frustrum technique". It is unclear what a view frustrum technique is.

Regarding claim 20, the term "non-intrusive manner" is a relative term which renders the claim indefinite. The term "non-intrusive manner" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Different people may view performance differently, so while one person may notice the game slow down, another may not. Further, different computers may have more memory, so the step of receiving may perform differently for one computer as opposed to another.

Further regarding claim 20, the claim recites that an effectiveness measure will be forwarded using a process that can be used for anything other than an effectiveness measure. Once the effectiveness measure is added to a communication packet, that communication packet can no longer be described as "used for purposes other than for forwarding the measure of advertising effectiveness". This seems paradoxical, and is unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 2-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Heckel (U.S. Patent No. 6,036,601).** Heckel teaches a gaming advertising method and system that includes all of the limitations recited in the above claims.

Regarding claims 2, 3, 6, 9, 10, 11, 13-15, Heckel teaches locating advertising tags (plug-ins) in a game (Column 3, Lines 52-54), storing a set of advertisements on the console (Column 4, Lines 49-58), and dynamically inserting advertisements from the set into the game code associated with the plug-ins (Column 4, Lines 49-58). All of this is done when the user logs onto the game server (Beginning at Column 4, Line 35), and thus, occurs while the game code is executing (when a user logs on, this is taken to be playing the game). From the specification, a dribble pipe appears to be a connection capable of transferring small amounts of information. The connections of Heckel have no such limitations. Therefore, Heckel's connection is taken to be a dribble pipe.

Regarding claim 4, Heckel takes into account scheduling information ("specific rate" is taken to meet the broad meaning of scheduling information), as well as advertising type and genre (demographic data is used as well) (Column 4, Lines 8-9).

Regarding claims 5 and 12, since Heckel teaches the computer as running the software (without crashing), the impact on performance is taken to be minimum.

Regarding claim 7, Heckel teaches the forwarding of information regarding the displaying of the advertisements (Column 3, Lines 4-9).

Regarding claims 17-19, Heckel teaches displaying the advertisement in a portion of the game while the game is being executed (Column 4, Lines 61-66), automatically generating an effectiveness measure by determining quality and measure of exposure, and forwarding that information to the advertisers (Column 5, Lines 29-37). Heckel also teaches determining if the advertisement was seen (Column 3, Lines 4-9). The determination is considered a view frustrum technique.

Regarding claims 20 and 21, Heckel teaches a communication channel for the game server to communicate with the ad server (Column 3, Lines 58-61). The statistical information is taken to travel over the same communication line. Once the advertisers receive the bill, this is taken to be an acknowledgement that the advertisement was received.

6. **Claim 16 is rejected under 35 U.S.C. 102(e) as being anticipated by Kusumoto (U.S. Patent No. 6,954,728).** Kusumoto teaches a method and system of

advertising in a virtual world that contains all of the limitations recited in the above claims.

Regarding claim 16, Kusumoto teaches multiple consumer clients as receiving advertising content in a virtual (game) world simultaneously (Column 5, Lines 37-46 and Column 6, Lines 1-27).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (U.S. Patent No. 6,036,601) in view of Rashkovskiy (U.S. Patent No. 6,616,533).**

Regarding claim 8, Heckel doesn't teach interaction between the user and the advertisement. Rashkovskiy teaches a game in which a player may click on an advertisement so that the game will pause and the user will be given the option of purchasing an item. It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow a game player to interact with advertising. This would allow immediate and abrupt feedback and profit for an advertiser.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to advertisements within gaming consoles:

U.S. Patent No. 6,928,414 to Kim


U.S. Patent No. 6,058,397 to Barrus

U.S. Pub No. 2001/0034661 to Ferreira

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JEFFREY D. CARLSON
PRIMARY EXAMINER

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